

## **REMARKS**

This amendment is intended as a full and complete response to the Office Action dated September 25, 2006. In the Office Action, the Examiner notes that claims 2-19 are pending, of which claims 2-6, 10 and 19 are rejected, and claims 7-9 and 11-18 are objected to. By this amendment, claims 4 and 19 are amended and claims 2, 3 and 5-18 continue unamended.

Claims 4 and 19 have been amended to change various reference numbers to conform to the specification and the drawings. No new subject matter has been added to the claims.

It is submitted that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner's indication of the allowability of claims 7-9 and 12-18 has been duly noted and appreciated. However, it is believed that rewriting claims 7-9 and 12-18 in independent form (claim 6) is not necessary, as they depend on a claim (claim 19) earnestly believed to be allowable over the prior art.

## **I. Rejection Over the Prior Art**

### **A. 35 U.S.C. §102**

The Examiner rejected Claims 10 and 19 under 35 U.S.C. §102 as being anticipated by Bangerter, U.S. Patent No. 3,547,169 (hereinafter “Bangerter”). It is respectfully submitted that claims 10 and 19 are patentable over the cited reference.

Specifically, claim 19 recites in part that “the clamping members (20) having at least one contact region (40) which forms, at least in the support position of the clamping members (20), a frontmost stop of the holding device (10) in the drive-in direction (22) of the power tool (2) for engaging a workpiece the fastening element (50) is being driven into, whereby the workpiece applies to the clamping members (20) the force in the direction opposite the drive-in direction.”

No such clamping members are disclosed in Bangerter. Rather, Bangerter discloses that:

“[t]he head 3 includes an annular nose washer 4 located on its front surface and a pair of jaws 5 pivoted on pivots 6 in slots formed in the head behind the nose washer 4. The nose washer is adapted to abut a work surface at the end of driving a screw.” (see Bangerter, col. 1, lines 69-73, emphasis added).

“The invention in this application is the provision of a means for locking the jaws 5 together during the delivery of a screw between the jaws 5. This means is adapted to release the jaws 5 in order for them to open during the final driving cycle of the screwdriver. This jaw holding means includes a fork 8 pivoted on the side of the head 3 on pivot axis 9 and having a pair of spaced arms 10 forming a U-shaped cross section adapted to pivot forward and extend partially over the forward ends of the jaws 5, thereby preventing them from pivoting open. ... The fork 8 includes a

short leg 14 pivoted in a kerf formed in the central portion of the fork on a pivot axis 15 and projecting a short distance forward of the nose washer 4. The leg 14 is provided with appropriate stops so that it is always inclined inwardly and forwardly relative to a line extending through the two pivot axes 15 and 9, hence, the leg 14 is always positioned away from an alignment "dead center" with these two pivot axes." (see Bangerter, col. 2, lines 4-31, emphasis added).

A rejection based on 35 U.S.C. §102 as in the present case, requires that the cited reference disclose each and every element covered by the Claim. Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. §102 requires no less than "complete anticipation . . . [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053. Bangerter fails to disclose all of the elements of claim 19.

In particular, Bangerter discloses that the leg 14 is a component of the fork 8, which in turn is a component of the jaw holding means. The jaw holding means is not a component of the jaws 5. Accordingly, the Bangerter patent fails to disclose the feature of "the clamping members (20) having at least one contact region (40) which forms, at least in the support position of the clamping members (20), a frontmost stop of the holding device (10) in the drive-in direction (22) of the power tool (2) for engaging a workpiece the fastening element (50) is being driven into, whereby the workpiece applies to the clamping members (20) the force in the direction opposite the drive-in direction." (Emphasis added).

Since Bangerter fails to disclose each and every feature of independent Claim 19, Bangerter, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Bangerter does not anticipate the present invention as defined in Claim 19, and the present invention is patentable over Bangerter.

Furthermore, claim 10 depends on claim 19 and recites additional features considered inventive. Therefore, it is submitted that claim 10 does not anticipate the present invention and is patentable over Bangerter. Withdrawal of the rejections is respectfully requested.

B. 35 U.S.C. §103

1. Claims 2 and 3

The Examiner rejected Claims 2 and 3 under 35 U.S.C. §103 as being obvious over Bangerter, U.S. Patent No. 3,547,169 in view of Folz, U.S. Patent No. 6,458,022. Claims 2 and 3 depend from independent claim 19 and recite additional features regarding the contact region (40) of the holding device. It is respectfully submitted that claims 2 and 3 are patentable over the cited reference.

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 103 for analyzing the features of a claim with respect to the prior art. It is well settled that [t]he test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110

USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). The combination of Bangerter and Folz fails to disclose or suggest the invention as a whole.

As discussed above, Bangerter discloses a “jaw holding means” having a leg 14, and a nose washer that is adapted to abut a work surface at the end of driving a screw. Folz discloses that “inserted into the free ends of the outer holding members 16 and 17 are pins 37 upon which rollers 38 are borne that engage the control cams 33 and 34, which are designed as grooves.” (See Folz, col. 3, lines 56-59). Thus, the combined cited patents merely disclose a jaw holding means having a leg for locking the jaws 5 together during the delivery of a screw between the jaws 5 and the holding members include rollers.

Nowhere in the combined patents is there any disclosure or suggestion of “the clamping members (20) having at least one contact region (40) which forms, at least in the support position of the clamping members (20), a frontmost stop of the holding device (10) in the drive-in direction (22) of the power tool (2) for engaging a workpiece the fastening element (50) is being driven into, whereby the workpiece applies to the clamping members (20) the force in the direction opposite the drive-in direction.” (Emphasis added). Therefore, the combination of Bangerter and Folz fails to disclose or suggest the invention as a whole.

As such, it is submitted that claims 2 and 3 are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, it is respectfully requested that the rejections be withdrawn.

## 2. Claims 4-6

The Examiner rejected Claims 4-6 under 35 U.S.C. §103 as being obvious over Bangerter, U.S. Patent No. 3,547,169 in view of Stevens, U.S. Patent No. 2,704,003. Claims 4-6 depend from independent claim 19 and recite additional features regarding the clamping members (20) of the holding device. It is respectfully submitted that claims 4-6 are patentable over the cited reference.

As discussed above, Bangerter discloses a “jaw holding means” having a leg 14, and a nose washer that is adapted to abut a work surface at the end of driving a screw. Stevens discloses

“[e]ach of the jaws has an angularly disposed shank portion 50 and 52 for the jaws respectively, and which extend through the aperture 20 into the interior of the casing 10. The shank upon their inwardly extending portions are provided with arcuate recesses 54 and 56 respectively through which extend fastening and pivot pins 58 and 60 respectively which are supported in any suitable manner by the opposite walls of the casing 10.” (See Stevens, col. 2, lines 4-12).

Thus, the combined cited patents merely disclose a jaw holding means having a leg for locking the jaws 5 together during the delivery of a screw between the jaws 5, and each of the jaws has an angularly disposed shank portion which extend through the aperture 20 into the interior of the casing 10 and are provided with arcuate recesses 54 and 56.

Nowhere in the combined patents is there any disclosure or suggestion of “the clamping members (20) having at least one contact region (40) which forms, at least in the support position of the clamping members (20), a frontmost stop of the holding device (10) in the drive-in direction (22) of the power tool (2) for engaging a workpiece the fastening element (50) is being driven into, whereby the workpiece applies to the clamping members

(20) the force in the direction opposite the drive-in direction.” (Emphasis added). Therefore, the combination of Bangerter and Stevens fails to disclose or suggest the invention as a whole.

As such, it is submitted that claims 4-6 are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, it is respectfully requested that the rejections be withdrawn.

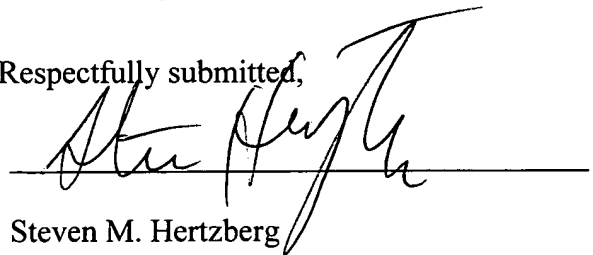
### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner’s Amendment and the case passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven M. Hertzberg", is written over a horizontal line.

Steven M. Hertzberg  
Reg. No. 41,834

Abelman, Frayne & Schwab  
666 Third Avenue, 10th Floor  
New York, NY 10017-5621  
212-885-9383